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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA–SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. C-05-01114 JW **ROUND 2 CABLE DEFENDANTS' JOINDER IN MOTION FOR SUMMARY JUDGMENT UNDER 35 U.S.C. § 112** Date: TBD Time: TBD Courtroom: 8, 4th Floor Judge: Honorable James Ware

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The Round 2 Cable Defendants[1] join in the Motion for Summary Judgment Under 35 U.S.C. § 112 filed by the Round 3 Defendants, and write separately to emphasize one argument raised in that motion: that all of the asserted claims that include the term "sequence of addressable data blocks" are invalid under § 112 as a matter of law.[2]

That conclusion flows directly from this Court's claim construction and Acacia's admissions. In its Third Claim Construction Order, the Court ruled that the term "sequence of addressable data blocks" encompasses sequencing based on time, but *also* is broad enough to encompass *other* forms of sequencing, not based on time. The Court stated that "the phrase 'ordering into . . . a sequence of addressable data blocks' is a very broad limitation which could include time encoding, as well as other ways of generating addressable data blocks." (Third Claim Constr. Order [Doc. #216] at 27 (ellipses in original)).

Recognizing that ruling's fatal consequences, Acacia then sought to undo it. Acacia asked the Court to reconsider its construction, and to hold instead that the claimed sequencing *must* be based on time encoding. (*See* Acacia's Motion for Reconsideration [Doc. #237] at 13-20.) The Court, however, refused to modify its construction. (*See* Fifth Claim Constr. Order [Doc. No. 259] at 14.)

As Acacia itself has recognized, the result is that claims that include the term "sequence of addressable data blocks" are neither described nor enabled under § 112, and are therefore invalid. Acacia has conceded numerous times that the Yurt patents fail to describe or teach *any* sequencing method other than time encoding—even though their specification makes clear that time encoding is only a "preferred" method of sequencing, and they describe using the patented method for subject matter unsuited for time encoding, such as "still pictures, . . . books, . . . [and] documents of various sorts[.]" ('992 patent at 6:10-15 and 7:60-63.) Acacia made this fatal concession multiple times in its motion for reconsideration, which included an entire section entitled, "There Are No Methods Unrelated to Time Disclosed Or Suggested In The Patent Specification For Achieving Addressability." (Acacia's Motion for Reconsideration [Doc. #237] at 16.) Acacia stated:

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[1] The following defendants join in this brief: Comcast Cable Communications LLC; Insight Communications, Inc.; Coxcom, Inc.; Hospitality Network, Inc.; Cable America Corp.; Charter Communications, Inc.; Wide Open West Ohio LLC; Armstrong Group; Massilon Cable TV, Inc.; East Cleveland Cable TV and Communications LLC; Mid-Continent Media, Inc.; Cannon Valley Communications, Inc.; US Cable Holdings, LP; Arvig Communications Systems; Sjoberg's Cablevision, Inc.; Loretel Cablevision, Inc.; NPG Cable, Inc.; Block Communications, Inc.; and Savage Communications, Inc.

[2] The term "sequence of addressable data blocks" appears in all of the asserted claims of the '992 patent and the '863 patent.

- "The patent specification does not disclose any method other than time encoding . . . for achieving addressability." (*Id.*)
- "Mr. S. Merill Weiss, Acacia's technical expert, testified at the September 8, 2005 Markman Hearing . . . that time encoding is the only scheme for addressing data blocks that is disclosed in the specification." (*Id.*)
- "Not only are no addressing schemes, other than time encoding, described in the patent, the only structure disclosed in the specification for placing the data blocks into a sequence of addressable data blocks is a time encoder . . . ." (*Id.*)
- "In fact, the only addressing scheme or structure for placing data into a 'sequence of addressable data blocks' that is illustrated in the patent specification is 'time encoding' . . . ." (*Id.*)

Acacia reiterated these concessions at the August 17, 2007 hearing on its motion for reconsideration. It emphasized that its own technical expert had testified that time encoding is the only addressing scheme that the specification disclosed, and that "*Indeed, this fact is not disputed.*" (Tr. of 8/17/07 Hrng. at 127; *see also id.* at 125 ("*[T]ime encoding is the only addressing scheme for addressing data blocks in the specification,*" and 165-66 ("*Nothing is disclosed that is not time. Only time is disclosed.*")) The Court countered, however, that—while the specification may indeed not describe any other method—the patent made clear that the claims were intended to cover other methods:

The Court: You say that the expert here tells me that that's the only embodiment.

Mr. Block: That's what he said.

The Court: But that's not what the patentee said. The inventor said the *preferred* addressing scheme is time encoding, and so it seems to me that *that must mean that there are other schemes but that this is the preferred among them.*

Mr. Block: No, that doesn't necessarily mean that. Preferred—well, first of all, he doesn't give any—even though he uses the word "preferred," *he discloses no other addressing*.

The Court: I agree with that.

Mr. Block: *It's not there.*

(*Id.* at 129-30.)

Acacia was candid with the Court about why it was straining for a construction that limited sequencing to time encoding—to try to preserve the patent's validity:

Mr. Block: And your question to me is why do we need to limit it? *And the reason is we may have validity issues.* We always have to look at a claim construction in terms of infringement but also in terms of validity . . . .

(*Id.* at 134.)

On that point, at least, Acacia was correct. The Federal Circuit has ruled time and again that patents must describe and enable the *full scope* of their claims, and that where patentees attempt to claim more than the patent specification supports, the claim is invalid. These disclosure requirements are "the quid pro quo of the patent system; the public must receive meaningful disclosure in exchange for being excluded from practicing the invention for a limited period of time." *Enzo Biochem v. Gen-Probe*, 296 F.3d 1316, 1330 (Fed. Cir. 2002). Their purpose "is to ensure that the scope of the right to exclude . . . does not overreach the scope of the inventor's contribution to the field of art as described in the patent specification." *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345-46 (2000). But that is exactly what the Yurt patentees attempted to do by claiming multiple methods of sequencing data, including time encoding and others, but disclosing only time encoding in the specification. Accordingly, the claims that do so are invalid. *See Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999-1000 (Fed. Cir. 2008) (invalidating claims that were broad enough to cover video games and movies because the specification taught the method only in video games).

For these reasons, and the others stated in the Round 3 Defendants' Motion, Defendants are entitled to summary judgment.

Dated: July 11, 2008

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